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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/728,830	12/08/2003	Che-Chih Chang	SUND 490	9295

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EXAMINER
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CARIASO, ALAN B

ART UNIT	PAPER NUMBER
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2875

DATE MAILED: 06/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/728,830

Applicant(s)

CHANG ET AL

Examiner

Alan Cariaso

Art Unit

2875

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Priority*

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

### *Drawings*

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the bottom frame movably coupled *within* the outer frame (claims 1 and 6) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

3. Claim 2 is objected to because of the following informalities: "the process" referring to "exchanging the light source", has not been defined as a process limitation in claim 1, but a functional phrase or intended use. In claim 2, it is suggested to address the phrase as --a process of exchanging the light source--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 1-5 rejected under 35 U.S.C. 102(e) as being anticipated by HAYASHIMOTO et al (US 6,870,582).

6. HAYASHIMOTO discloses a backlight module (figs.5-6), at least comprising: an outer frame (12); a bottom frame (20) movably coupled within the outer frame (12, fig.6); an upper frame (36) movably coupled within the outer frame (12) and disposed above

Art Unit: 2875

the bottom frame (20); a reflector (43) disposed under the upper frame (36) and on the bottom frame (20); at least a light source (42) disposed under the upper frame (36) and above the reflector (43); a light guide plate (41) disposed under the upper frame (36) and above the reflector (43); at least a lamp holder (holder or housing surrounding tube lamps 42 as best viewed in fig.5) which is within the upper frame (36) and adjacent to the light guide plate (41); a multilayer optical film (45,46) disposed above the lamp holder (42) and the light guide plate (41); a display panel (38) disposed on the upper frame (36) and the multilayer optical film (45,46) within the outer frame (12); wherein the display panel (38) is a liquid crystal display panel (col.3, line 54); wherein the light source (42) is a CCFL (col.4, lines 4-5).

7. In regards to phrases in claim 1, "wherein the bottom frame can be separated from the outer frame when the backlight module is inverted", "wherein the reflector can be removed after the bottom frame is separated from the outer frame", "wherein the light source can be exchanged after the reflector is removed", "functioning to guide the light reflected by the reflector", "functioning to house the light source", "to filter the light guided by the light guide plate", "functions to receive the light filtered through the multilayer optical film so that the image is visible when the light reaches and penetrates the display panel", any recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. It appears that backlight module is capable of at least being exchanged the light source and be

removed of the reflector by inversion of the backlight module, and removal of the lower frame. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 370 F.2d 576, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 312 F.2d 937, 939, 136 USPQ 458, 459 (CCPA 1963).

8. Regarding claim 2, please note that the method of forming or processing the device is not germane to the issue of patentability of the device itself. Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Therefore, these (i.e. method) limitations have not been given patentable weight.

### ***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 6-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over HAYASHIMOTO et al (US 6,870,582).

Art Unit: 2875

11. HAYASHIMOTO discloses the claimed structure and an illustration (fig.4) of inverting the backlight module and separating the bottom frame (14 or 20) as shown of accessible fasteners (18) removed and visible access to hooks (30) in that inverted position. However, HAYASHIMOTO does not disclose the steps of removing the reflector thereafter and exchanging the light source. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the backlight module of HAYASHIMOTO et al to include the steps of removing parts as in the reflector and exchange the light source, since it was well known in the art to exchange spent light source(s) by carefully removing parts adjacent the light source in order to gain free access to the light source and replace the spent light source with a working light source while not damaging all the parts of the device.


### ***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. TAKAHASHI et al (US 5,889,572) shows an LCD module device (fig.3) that includes an outer frame (350), and LCD (100), upper frame (800), backlight with light guide (440), lamp (430) with holder (450) and optical sheets (460), and an accessible bottom frame (300).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan Cariaso whose telephone number is (571) 272-2366. The examiner can normally be reached on 9-5:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Alan Cariaso  
Primary Examiner  
Art Unit 2875

June 27, 2005  
AC